



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,057	08/01/2001	Valtteri Niemi	324-010477-US (PAR)	4430
2512	7590	07/23/2009	EXAMINER	
Perman & Green, LLP 99 Hawley Lane Stratford, CT 06614			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2437	
			MAIL DATE	DELIVERY MODE
			07/23/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/920,057	<b>Applicant(s)</b> NIEMI ET AL.	
	<b>Examiner</b> Zachary A. Davis	<b>Art Unit</b> 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,5,7-14,19,21,23,24,27 and 28 is/are allowed.
- 6) ☒ Claim(s) 2,6,15,16,18,22,31,32 and 47-54 is/are rejected.
- 7) ☒ Claim(s) 4,17,20,25,26,29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 February 2009 did not fully comply with the requirements of 37 CFR 1.121. In response to the notice of non-compliant amendment mailed on 08 April 2009, a supplemental reply was received on 17 April 2009, which has been entered.

2. By the supplemental reply, Claims 1-3, 17, 18, 20-32, 47, and 49-52 have been amended. New Claims 53 and 54 have been added. No claims have been canceled. Claims 1-32 and 47-54 are currently pending in the present application.

### ***Response to Amendment***

3. The response filed 17 April 2009 is not fully compliant with the requirements of 37 CFR 1.121. In particular, Claim 50 includes text that is enclosed by single brackets (see line 5). It appears that this is intended to indicate deleted text; however, 37 CFR 1.121(c)(2) states that double brackets placed before and after deleted characters may

Art Unit: 2437

be used to show deletion (not single brackets). However, because the present response appears to be a *bona fide* attempt to advance the prosecution of the present application and Applicant's intent appears clear, the present response has been treated as though it were fully in compliance with the provisions of 37 CFR 1.121.

### ***Response to Arguments***

4. Applicant's arguments, see pages 11-12 of the present response (filed 17 April 2009), with respect to the rejections under 35 U.S.C. 103(a) have been fully considered and are persuasive. In particular, the Examiner acknowledges that none of the cited art (in particular the 3G specifications and the portions of Fauconnier that include descriptions of those specifications which were previously relied upon) teaches or suggests the modification of counter parameters as now recited in each of independent Claims 1, 17, 49, and 50. The rejection of Claims 1, 2, 4-8, 11, 12, 17, 19-21, 23, 24, 27, 28, 49, and 50 under 35 U.S.C. 103(a) has been withdrawn.

### ***Claim Objections***

5. The objections to Claims 3, 18, 22, 31, 32, 47, 48, 51, and 52 under 37 CFR 1.75(c) as being in proper multiple dependent form are withdrawn in light of the amendments to the claims.

Art Unit: 2437

6. The objection to Claim 1 for informalities is withdrawn in light of the amendments to the claim.

7. Claims 4 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Specifically, Claims 4 and 20 recite that the input parameters comprise a counter parameter; however, independent Claims 1 and 17, from which Claims 4 and 20 depend, respectively, now recite a counter parameter of the operating parameters, on the basis of which the input parameters are created. Therefore, the independent claims already require a counter parameter and Claims 4 and 20 are not further limiting.

8. Claims 17, 25, 26, 29-32, 51, and 53 are objected to because of the following informalities:

Claim 17 recites the phrase “a user equipment” in lines 5-6. This is somewhat awkwardly phrased, as it is uncommon to use the phrase “an equipment” or similar. It appears that this should be replaced with simply “user equipment”, or alternately with similar language such as “a user terminal”. Additionally, Claim 17 recites “the radio access network of the packet-switched [TDMA] mobile system” in lines 7-8 of the claim. Since this appears to be the first mention of this radio access network, it may have been intended that “the radio access network” instead read “a radio access network”.

Art Unit: 2437

Claims 25, 26, and 29-32 each recite “the user equipment comprises” (see Claim 25, line 2; Claim 26, line 4; Claim 29, line 2; Claim 30, lines 3-4; Claim 31, line 2; and Claim 32, line 3). The corresponding recitations of “[u]ser equipment” in the preambles of each of these dependent claims were changed to read simply “[t]he apparatus”; it may have been intended for the limitations further limiting the user equipment to also be amended to refer to the apparatus more generally. However, the claims as written are not indefinite, because there is sufficient antecedent basis for the limitation of the user equipment. Therefore, Applicant is respectfully requested to clarify on the record whether corresponding amendments were intended (either by making the amendments if they were, in fact, intended, or stating that it was intended that the claims continue to refer to the user equipment if that is the case).

Claims 51 and 53 each recite “a user equipment”. Similar to Claim 17, this is somewhat awkwardly phrased, as it is uncommon to use the phrase “an equipment” or similar. It appears that this should be replaced with simply “user equipment”, or alternately with similar language such as “a user terminal”.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

9. The rejection of Claims 17, 19-21, and 23-30 under 35 U.S.C. 112, second paragraph, as indefinite is withdrawn in light of the amendments to the claims. The rejection of Claims 2 and 50 is maintained and Claims 6, 15, 16, 18, 22, 31, 32, 47-49,

Art Unit: 2437

and 51-54 are newly rejected for the reasons detailed below, in light of the amendments to the claims and further consideration of the claims in general.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2, 6, 15, 16, 18, 22, 31, 32, and 47-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites “creating input parameters of a format required by the encryption algorithm on the basis of operating parameters of the radio access network of the packet-switched time division multiple access mobile system and at least a counter parameter of the operating parameters is modified depending on a protocol currently used”. The second portion of this limitation (“a counter parameter... is modified”) is not in parallel structure with the remaining limitations of the claim, and it is not clear if that latter portion of the limitation is intended to be an additional step performed as part of the claimed method. This renders the claim indefinite.

Claim 50 recites “means for decrypting data received using an encryption algorithm” in line 2. It is unclear how the encryption algorithm is used to receive the data (noting that the placement of the phrase “using an encryption algorithm” indicates that it is intended to modify “received”). Further, the phrase “a radio access network of a packet switched time division multiple access mobile system employing wideband code division multiple access” in lines 4-6 is generally unclear. It is not clear if the network uses TDMA or WCDMA since both are recited. Additionally, the claim recites “means

Art Unit: 2437

for creating input parameters of a format required by the encryption algorithm on the basis of operating parameters of the radio access network of the packet-switched time division multiple access mobile system and at least a counter parameter of the operating parameters is modified depending on a protocol currently used". The second portion of this limitation ("a counter parameter... is modified") is not in parallel structure with the remaining limitations of the claim, and it is not clear if that latter portion of the limitation is intended to be another function of the recited means plus function limitation. This renders the claim indefinite.

Claim 18 recites "the agreed format" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Although there is reference to an agreed format in Claim 17, Claim 18 also depends in the alternative from Claim 50, which does not include any reference to an agreed format. However, for purposes of interpreting the prior art, "the agreed format" has been assumed to refer to the required format recited in Claim 50 as well as the agreed format recited in Claim 17.

Claim 47 recites the limitation "wherein the apparatus is a packet-switched time division multiple access mobile system". This is somewhat unclear; in particular, it is not clear if this is intended to refer to mobile system as a whole (including the network and user equipment, for example) or if it was intended to refer only to the radio access network, as was previously recited in canceled Claim 33, for example. Further, Claim 47 recites the limitation "means for receiving information on a last used extended TDMA frame number or hyper frame number to the user equipment when a connection of the user equipment changes". This is generally unclear, particularly with reference to the



Art Unit: 2437

use of the phrase “to the user equipment”. It is not clear how the mobile system as a whole can comprise means for receiving information to user equipment; additionally, the phrase is generally unclear and narrative.

Claims 52 and 54 each recite the limitation “a GPRS/EDGE radio access network”, which name protocols in general. This renders the claim scope uncertain because protocols are subject to evolving standards and go through several version revisions, and therefore the protocol name cannot be used to properly identify the specific methods, standards, or products that are associated with the protocol name.

Claims not explicitly referred to above are rejected due to their dependence on a rejected base claim.

### ***Allowable Subject Matter***

12. Claims 1, 3, 5, 7-14, 19, 21, 23, 24, 27, and 28 are allowed.

13. Claims 2, 4, 6, 15-18, 20, 22, 25, 26, 29-32, and 47-54 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and/or the objections set forth in this Office action.

14. The prosecution history as a whole makes clear the reasons for indicating allowable subject matter (see especially Applicant's arguments filed 17 April 2009) and therefore reasons for indicating allowable subject matter are not necessary. See 37 CFR 1.104(e). See also the Office action mailed 04 April 2006 and the response to arguments above.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. De Benedittis et al, WIPO Publication WO01/72081, discloses methods for handover procedures between GSM and 3G systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachary A Davis/  
Examiner, Art Unit 2437